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**THIS DISPOSITION
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Paper No. 9
RFC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **The After-School Corporation**

Serial No. 75/485,536

Kristopher E. Ahrend of Simpson Thacher & Bartlett for The After-School Corporation.

Kathleen Keener Elsner, Trademark Examining Attorney, Law Office **103** (Michael A. Szoke, Managing Attorney).

Before Simms, Cissel and Wendel, Administrative Trademark Judges.

Opinion by **Cissel**, Administrative Trademark Judge:

On May 15, 1998, applicant applied to register the mark "THE AFTER-SCHOOL CORPORATION" for "charitable services, namely providing resources to entities for organizing and operating programs to enrich children and young adults after school hours," in Class 42. The basis for the application was applicant's assertion that it possessed a bona fide intention to use the mark in commerce in connection with the recited services.

In addition to raising other issues which were subsequently resolved, the Examining Attorney refused registration under Section 2(e)(1) of the Lanham Act on the ground that the mark sought to be registered is merely descriptive of the services with which applicant intends to use it. She reasoned that "AFTER-SCHOOL" identifies a feature or characteristic of the services, namely that the purpose of them is to provide after-school activities. She noted that "CORPORATION" is descriptive of applicant's business organization, and she required applicant to disclaim this word apart from the mark as shown. Further, she held applicant's recitation of services to be indefinite and required amendment thereto. She suggested that if it were accurate, applicant could adopt the following: "charitable services, namely providing resources to entities organizing and operating programs to enrich children and young adults after school hours, said resources being [specify]."

Applicant responded to the first Office Action by providing the required disclaimer, amending its recitation of services and arguing that the mark is not descriptive of the identified services. The amendment identified the services as "charitable fund-raising services and advisory services provided therewith; namely, the provision of

resources to entities that organize and operate programs designed to enrich children and young adults after school hours, said resources being funding in the form of grants to such entities, training for the employees of such entities and consulting services pertaining to organizational management and program content," in Class 36.

Submitted in support of applicant's contention that its mark is not merely descriptive of these services was the declaration of Robert Yarbrough, Acting General Counsel for applicant. In his declaration, Mr. Yarbrough explains in more detail that applicant provides funding and other resources, in the form of training and consulting services, to community-based organizations which provide programming for school-aged children during the after-school hours. Applicant argued that the dominant component in its mark, "AFTER-SCHOOL,"

"... arguably denotes a temporal concept--a time of day--that is particularly relevant to individuals who either attend school or whose vocation is associated with school. Neither the solicitation of donations [n]or the provision of funding and resources to other organizations relates in any manner to the concept of school generally or any particular time of day. Similarly, the phrase 'after-school' does not suggest or even imply the provision of funding or other resources to community-based organizations. The only relevance the phrase 'after-school' holds toward the services Applicant provides is that the phrase arguably describes a time the day at which some of the

organizations that receive funding from Applicant provide their services. Thus, Applicant's mark, at best, is suggestive of the services offered by these organizations and not the services offered by Applicant itself."

The Examining Attorney was not persuaded by applicant's argument on the issue of descriptiveness. The refusal to register under Section 2(e)(1) of the Lanham Act was repeated and made final. She restated her reasoning that "[t]he mark merely describes a corporation created for the purpose of providing for after-school programs, which is exactly what applicant claims to be." Attached to the final refusal to register were excerpts from eight articles retrieved from the Nexis® database of publications. These articles show that fund-raising activities are conducted for the benefit of after-school programs.

Additionally, the Examining Attorney held applicant's amended recitation of services to be unacceptable because it includes services which are properly classified in additional classes. The requirement for an acceptable recitation of services was repeated and made final.

Applicant timely filed a Notice of Appeal. Both

applicant and the Examining Attorney filed appeal briefs,¹ but applicant did not request an oral hearing before the Board.

The issues before the Board in this appeal are therefore whether the recitation of services, as amended, is acceptable and whether applicant's mark is merely descriptive of the services within the meaning of Section 2(e)(1) of Lanham Act. Based on careful consideration of the record before us and the arguments of both the Examining Attorney and applicant, we find that the recitation of services is unacceptable because it includes services properly classified in additional classes, and that the refusal to register based on Section 2(e)(1) is well taken.

It cannot be disputed that the amended recitation of services includes activities which are classified not just in Class 36, but also in Classes 41 and 42. The application states that applicant raises funds and provides advisory services in connection with fund-raising

¹ The Examining Attorney properly objected to the Board's consideration of the additional evidence applicant submitted with its appeal brief. Trademark Rule 2.142(d) requires the record to be complete prior to the filing of a Notice of Appeal. Unless the Board has granted a request for it to consider additional evidence submitted after that time, late-filed evidence will not be considered. Accordingly, the objection of the Examining Attorney is sustained. We have not considered the exhibits submitted with applicant's brief on appeal.

activities. These services are plainly appropriate for Class 36. The recitation of services states that applicant will be using the mark to identify the provision of resources to entities that organize and operate programs designed to enrich children and young adults after school hours. We assume that what the Examining Attorney had in mind when she suggested the word "resources" had to do with the financial assistance applicant apparently provides, but when asked to specify the nature of the "resources" it provides, applicant indicated that they include not just funding, but also training for the employees of the entities which organize and operate after-school programs, as well as consulting services pertaining to organizational management and program content. Such training is properly classified in Class 41, and consulting services pertaining to organizational management belong in Class 42. In view of the fact that applicant has neither amended the application to recite its services in only one class nor submitted the requisite amendment, fees and declarations with respect to the two additional classes, the requirement for applicant to either do so or strike the references to consulting and training is affirmed.

Turning then to the refusal to register under Section 2(e)(1) of the Lanham Act, we note that a mark is merely

descriptive if it immediately and forthwith conveys information regarding a quality, characteristic, function, feature, or purpose of the services with which it is, or will be, used. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); In re Bed & Breakfast Registry, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986); In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979).

Notwithstanding applicant's arguments to the contrary, the mark it seeks to register is merely descriptive of the services specified in the application, as amended. As noted by the Examining Attorney, applicant describes itself as being "dedicated to enhancing the quality and availability of... after-school programs." (Applicant's brief at p.2). "THE AFTER-SCHOOL CORPORATION," when considered in conjunction with the services specified in the application, immediately and forthwith conveys the fact that applicant is a corporation, and that the focus of applicant's activities is after-school programs. The fact that applicant does not itself run after-school programs, but rather funds them, trains people to operate them, and consults with respect to the management of them does not make "AFTER-SCHOOL" any less descriptive of the central characteristic of applicant's services, that they relate to after-school programs.

Prospective purchasers of applicant's services are organizations and individuals in need of money and assistance for providing after-school programs. Such people, upon seeing applicant's mark in connection with these services, will immediately make the connection between the mark and the purpose or use of the fund-raising and other services applicant offers. No imagination or mental gymnastics are required to understand that this mark, when considered in connection with the charitable services identified in the application, refers to the fact that applicant's services all relate to after-school activities or programs. Because this is a distinguishing feature or characteristic of the services, the mark is merely descriptive within the proscription of Section 2(e)(1) of the Lanham Act.

Decision: The requirement for an acceptable recitation of services is affirmed and the refusal to register because the mark is merely descriptive is also affirmed.

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